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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,873

07/16/2007

John Cracknell

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VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

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DELIVERY MODE

11/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,873	Applicant(s) CRACKNELL ET AL.	
	Examiner LESLIE A. NICHOLSON III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Claims 1-17,26-36 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/8/2009.

The traversal is on the ground(s) that, regarding claims 1 and 18, “the claims are so interrelated that there could be no serious burden on the Examiner if required to perform a search covering both groups of claims” and “each step of the claimed automated process correlates to a particular structure of the apparatus”. In response, the Examiner notes claim 18 does not recite a structure that feeds successive individual sheets to a folding apparatus. Furthermore, Group I discloses additional limitations to its invention not disclosed by Group II, including at least introducing a cover, a sensor, inhibiting registration, etc.

Applicant further traverses on the ground that “claim 36 of Group IV... only differs from claim 18 of Group II in that it recites a sheet collector in accordance with claim 26”. In response, the Examiner notes that Applicant has not traversed the Restriction

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Requirement between Groups II and III and further notes that Group II does not disclose at least a saddle, front stop, or back stop, which is disclosed in Group III.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “adhesive applicator mounted above the supporting surface” (claim 19) and “a second retractable finger” (claim 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 24 recites the collector also comprising a second retractable finger; however, the specification does not appear to disclose this element.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites a second retractable finger, however, a first retractable finger was not claimed in claim 18. For the purpose of this Action, claim 24 will be treated so as to depend from claim 23, as it appears was Applicant's intention.

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Claim 24 recites the limitation "the retractable fingers". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 18,19,22 are rejected under 35 U.S.C. 102(b) as being anticipated by McCain USP 4,050,686.

McCain discloses, regarding claim 18, binding apparatus for binding sheets together, the apparatus comprising: sheet folding apparatus (340; fig.1,5) for individually folding sheets along a fold line; a supporting surface (see fig.2) on which the sheets are supported as adhesive is applied from an adhesive applicator (300; fig.2) to the fold line of selected sheets prior to stacking; and a sheet collector (see fig.1) for stacking successive sheets such that the fold lines of each sheet are substantially aligned.

Regarding claim 19, wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line (fig.2).

Regarding claim 22, wherein the supporting surface includes one or more driven rollers to urge passage of a sheet along the surface (283 and unlabeled rollers adjacent belts 296 in fig.2).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18,19,23-25, as best understood by the examiner (see ¶4-7), are rejected under 35 U.S.C. 103(a) as being unpatentable over Cracknell WO 01/34403 in view of Baumann PGPub 2001/0048862.

Cracknell discloses, regarding claim 18, binding apparatus for binding sheets together, the apparatus comprising: sheet folding apparatus (12,13; fig.1) for individually folding sheets along a fold line; a supporting surface (33; fig.1); and a sheet collector (15) for stacking successive sheets such that the fold lines of each sheet are substantially aligned.

Regarding claim 23, wherein the sheet collector comprises a stacking area with collection arm (16) and a first retractable finger (21; fig.1,2B,3) arranged above a downstream end of the stacking area.

Regarding claim 24, wherein the collector also comprises a second retractable finger (21), the retractable fingers being arranged above the stacking area (fig.2B).

Regarding claim 25, wherein the sheet collector comprises a stacking area for receiving sequential delivery of part-folded sheets and a finger (21) located above a downstream end of the stacking area and arranged for rotation about an axis

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substantially transverse to the sheet transport direction (which can be the direction of conveyance of the sheets by way of elements 36 or 41; fig.1).

Cracknell does not expressly disclose an adhesive applicator or the limitations of claim 19.

Baumann teaches the use of an adhesive applicator (30), , wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line for the purpose of joining each signature to one another in order to collect the signature into groups to form the desired end product (¶0002,0019-0022).

At the time of invention it would have been obvious to one having ordinary skill in the art to provide an adhesive applicator, wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line, as taught by Baumann, in the device of Cracknell, for the purpose of joining each signature to one another in order to collect the signature into groups to form the desired end product.

12. Claims 20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cracknell WO 01/34403 in view of Baumann PGPub 2001/0048862 further in view of Leu USP 5,716,182.

Cracknell discloses substantially all the limitations of the claim (see ¶19), but does not expressly disclose the limitations of claims 20,21.

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Leu teaches the device wherein the adhesive applicator (20) is mounted in or adjacent a slot in the supporting surface and is arranged to deliver adhesive upwardly through the slot to the inside of the fold line and wherein the adhesive applicator is arranged to deliver adhesive to the second and subsequent sheets of a stack (C6/L48-57) for the purpose of ensuring reliable adhesive bonding between individual sheets without problems of blockage (C2/L10-17).

At the time of invention it would have been obvious to one having ordinary skill in the art to mount the adhesive applicator in or adjacent a slot in the supporting surface and is arranged to deliver adhesive upwardly through the slot to the inside of the fold line and wherein the adhesive applicator is arranged to deliver adhesive to the second and subsequent sheets of a stack, as taught by Leu, in the device of Cracknell, for the purpose of ensuring reliable adhesive bonding between individual sheets without problems of blockage.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE A. NICHOLSON III whose telephone number is (571)272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leslie A Nicholson III/
Examiner, Art Unit 3651
11/10/2009